



UNITED STATES PATENT AND TRADEMARK OFFICE

NIK
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,762	05/01/2001	Robert Shea	31910.000014	5008

23387 7590 03/04/2003

Stephen B. Salai, Esq.
Harter, Secrest & Emery LLP
1600 Bausch & Lomb Place
Rochester, NY 14604-2711

EXAMINER	
JIMENEZ, MARC QUEMUEL	
ART UNIT	PAPER NUMBER

3726

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/846,762	SHEA ET AL. <i>MH</i>
Examiner	Art Unit	
Marc Jimenez	3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 February 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/11/03 has been entered.

Specification

2. The amendment filed 2/11/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: “the compliant layer 44 will experience **continual elastic deformation**” (see page 18, lines 18-19 of the amendment filed 2/11/03).

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. **Claims 1-25** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the limitation “elastically deformable” added

to claims 1, 4, 16, 20, 22, 24, and 25 is new matter. The original specification had support for a compliant layer which was described as follows: "It should be recognized that in an absolute sense, all materials are more or less compliant and that as used herein, material is compliant or non-compliant depending on the extent to which it deforms in the transport mechanism of the invention. Preferably, the material forming the compliant core provides for an amount of shear, in contrast to the non-compliant material, which exhibits substantially no shear." and "As used herein, compliant means having a tendency to deform significantly in use,...". However, there is no support for the "elastically deformable" limitation.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 3, 11, 15, 16, 20-23, and 25** are rejected under 35 U.S.C. 102(b) as being anticipated by Gehrer (2,761,547).

Gehrer teaches a roller for a roller assembly, the roller comprising: a shaft 1 and a first tire 2' mounted relative to the shaft 1', the first tire 2' including: an elastically deformable core 6' affixed relative to the shaft 1' for rotation with the shaft 1', and a non-compliant layer 5' connected to the core 6' for rotation with the core 6'. The limitation that the shaft has a linear variance less than 0.03 inches per linear foot does not further limit the

structural limitations of the roller and therefore has not been given patentable weight. The non-compliant layer 5' includes a metal tube (col. 2, lines 61-65). Note that there are numerous tires 2' mounted on the shaft 1'. Note that the non-compliant layer 2' is concentric in the unloaded configuration and the shaft is offset from the concentric state when in the loaded state. The non-compliant layer 5' is selected to preclude a deformation of the non compliant layer 5' in the loaded state sufficient to induce skewing or scuffing.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrer in view of Okumura et al. (4,517,719).

Gehrer teaches the invention cited with the exception of the shaft being made of plastic.

Okumura et al. teach a shaft 1 made of plastic (col. 4, line 18).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrer with a plastic shaft, in light of the teachings of Okumura et al., in order to reduce the weight of the shaft.

Furthermore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the

Art Unit: 3726

general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

8. **Claims 4-6 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrer in view of Matson (3,866,716).

Gehrer teaches the invention cited with the exception of the core being a cellular structure.

Matson teaches that it is well known in the art to use a cellular structure for a core (col. 3, lines 32-34).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrer with a cellular core structure, in light of the teachings of Matson, in order to provide a compressible, light weight, core material.

Note that Matson teaches using polyurethane for the cellular structure.

With respect to claim 5, Gehrer/Matson teach the invention cited above with the exception of the cellular structure being of an open cell structure.

At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have used an open cell structure because applicant has not disclosed that using an open cell structure provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the closed cell structure taught by Matson, or the claimed open cell structure, because both cell structures perform the same

function of providing an elastic layer equally well. Therefore, it would have been an obvious matter of design choice to modify Gehrer/Matson to obtain the invention as specified in claim 5.

Furthermore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

9. **Claims 7, 13, 17, and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrer in view of Eiji (JP 08169573).

Gehrer teaches the invention cited with the exception of the non-compliant layer being made of elastomeric material/plastic/rubber.

Eiji teaches a layer of elastomeric material/plastic/rubber 3b over a foam layer 3a.

Furthermore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

10. **Claims 8-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrer in view of Blackwood-Murray et al. (4,440,295).

Gehrer teaches the invention cited with the exception of the non-compliant layer having a durometer between 35 and 60 Shore A.

Blackwood-Murray et al. teach a non-compliant layer having a durometer between 35 and 60 Shore A.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrer with a non-compliant layer having a durometer between 35 and 60 Shore A, in light of the teachings of Blackwood-Murray et al., in order to provide a surface that has a better gripping surface.

Furthermore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

11. **Claims 12 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrer in view of Sawa et al. (5,553,845).

Gehrer teaches the invention cited with the exception of having a coefficient of friction material.

Sawa et al. teach a coefficient of friction (abstract, lines 1-2) enhancing material 7 on a tube 4.

It would have been obvious to one of ordinary skill in the art, at the time of the invention,

to have provided the invention of Gehrer with a coefficient of friction layer, in light of the teachings of Sawa et al., in order to provide a surface which has good friction and is not affected by changes in temperature or humidity as suggested by Sawa et al., see abstract, lines 1-3.

12. **Claim 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrer in view of view of Eiji as applied to claim 13 above, and further in view of Sawa et al.

Gehrer/Eiji teaches the invention cited with the exception of having a coefficient of friction material.

Sawa et al. teach a coefficient of friction (abstract, lines 1-2) enhancing material 7 on a tube 4.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrer/Eiji with a coefficient of friction layer, in light of the teachings of Sawa et al., in order to provide a surface which has good friction and is not affected by changes in temperature or humidity as suggested by Sawa et al., see abstract, lines 1-3.

Response to Arguments

13. Applicant's arguments with respect to Claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

14. Applicant argues that “elastically deformable” or “compliant” material is further described on page 6, line 18 and from the bottom of page 8, line 25 through page 9, line 23, however, there is no evidence of “elastically deformable” in any of these recitations.

Contact Information

15. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**. The examiner can normally be reached on **Monday-Friday, between 5:30 am- 2:00 pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335

Application/Control Number: 09/846,762
Art Unit: 3726

Page 10

Petitions/Special Programs (703) 305-9285
Terminal Disclaimers (703) 305-8408
PCT Help Desk (703) 305-3257

If the information desired is not provided above, or a number has been changed, please call the general information help line below.

Information Help line 1-800-786-9199
Internet PTO-Home Page <http://www.uspto.gov/>

MJ 
February 27, 2003


GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700